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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,183	09/13/2000	Stephanie Ann Suzuki	36.P285	8007
5514	7590	06/15/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/661,183	SUZUKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thierry L. Pham	2625	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7,11-18,22-28,32-36,39-43 and 46 is/are rejected.
- 7) Claim(s) 8-10,19-21,29-31,37,38,44 and 45 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 3/17/06.
- Claims 1-46 are pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7, 11-18, 22-23, 24-28, 32-36, 39-43, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (Tan) (U.S. 5,978,560).

With respect to claims 1, 3, 11, 12, 14, 22, 23, 32, 33, 39, 40, and 46, Tan discloses a server (400) for storing reproduction data; at least one attachment unit (420) coupled to the server, and comprising means for interfacing with a portable memory device (600) having a reference to the data (*column 4, lines 25-36*); first and second reproduction devices (500) coupled to the attachment unit (*figure 1*), the first reproduction device capable of performing a first reproduction of the data and the second reproduction device capable of performing a second reproduction of the data, the second reproduction being different from the first reproduction (*column 3, lines 2-8*), and rule processing means for processing a rule set (*instructions or attributes*) which includes selection criteria for selecting the reproduction data (*which reads on*

*associating a set of print jobs with a set of physical and logical printers, column 3, lines 46-64)* to determine whether to reproduce the reproduction data based on whether the reproduction data satisfies selection criteria (*column 3, lines 2-57, column 4, lines 12-22, column 5, line 62 to column 6, line 4, and column 6, lines 38-60*), wherein the attachment unit requests the reproduction data from the server for use by the reproduction device if the reproduction data satisfies the selection criteria (*column 3, lines 29-37*).

With respect to claims 2, 4, 13, 15, 24, and 25, Tan discloses a user interface (column 5, lines 41-50).

With respect to claims 5, 6, 7, 16, 17, 18, 26, 27, 28, 34, 35, 36, 41, 42, and 43, Tan discloses an auto-print and auto view feature (column 3, lines 46-57 and column 7, lines 20-32).

### **Allowable Subject Matter**

Claims 8-10, 19-21, 29-31, 37, 38, 44, and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 3/17/06 have been fully considered but they are not persuasive.

- Regarding to independent claims 1, 12, 23, 33, and 40, the applicants argued the cited prior art of record (US 5978560 to Tan et al) fails to teach and/or suggest the claimed feature that a determination of whether to reproduce reproduction data is based on whether the reproduction data satisfies selection criteria for selecting the reproduction data, wherein the selection criteria is included within a rule set.

In response, the examiner disagrees with the applicants' arguments/assertions. Tan clearly teaches a determination of whether to reproduce reproduction data is based on whether the reproduction data satisfies selection criteria for selecting the reproduction data, wherein the selection criteria is included within a rule set (associating a set of print job attributes (col. 3, lines

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50-55) to a set of logical printers). An example of print job attributes (i.e. print job identifier, print job extension such as .doc, .txt, and etc.) as shown in col. 4, lines 50 to col. 5, lines 4. The applicants also stated the Examiner was previously agreed to withdraw a rejection based upon above arguments during a telephone interview on March 7, 2006. There is no record stating the Examiner was greed to withdrawn a prior art rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham

  


GABRIEL GARCIA  
PRIMARY EXAMINER